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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,189	09/10/2003	Hidehito Sasaki	Q75431	3227
23373	7590	02/23/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				GILLIAM, BARBARA LEE
ART UNIT		PAPER NUMBER		
		1752		

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/658,189 Barbara L. Gilliam	<b>Examiner</b> SASAKI ET AL.	<b>Art Unit</b> 1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 January 2004 & 10 September 2003.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-20 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 10 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/20/2004 &amp; 9/10/2</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claims***

2. Claims 1-20 are present.
3. Claims 1-2, 5-20 are product-by-process claims or dependent on a product-by-process claim of which the process is the treatment with the aqueous solution containing one or more cations. Applicant is reminded of MPEP 2113: "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 1, 5, 7, 9, 11, 13, 15, 17, 19 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an aluminum support, does not

reasonably provide enablement for any support. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The specification only supports treatment of an aluminum support with the aqueous solution containing one or more divalent or multivalent cations. No other support is discussed.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5, 9, 11, 13, 15, 17, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Takita et al. (US 6,114,089).

a. Takita et al. teach a positive working photosensitive lithographic printing plate comprising an aluminum substrate, an intermediate layer and a positive working photosensitive layer wherein the aluminum substrate is anodized and rendered water-wettable. The intermediate layer contains a polymer comprising a unit comprising an acid group interacting with an alumina layer and a unit comprising an onium group

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interacting with the water-wettable layer (abstract; claims; column 3, line 4 – column 15, line 44). The aluminum plate is grained, etched, anodized and subjected to a silicate treatment wherein the silicate treatment is carried out by immersing the plate in an alkali metal silicate aqueous solution. The aqueous solution can further contain an alkaline earth metal salt such as strontium nitrate in an amount of 0.01 to 10% by weight (column 18, lines 19-49). This silicate treatment comprising the alkaline earth metal salt meets the present limitations for the treatment with an aqueous solution containing one or more divalent or multivalent cations. The printing plate precursor is imagewise exposed to light and developed (column 25, lines 28-58). See also Examples 1 to 4 and Developer (A).

8. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawauchi et al. (US 6,843,175 B2).

a. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

b. Kawauchi et al. teach a support for a lithographic printing plate which is obtained by performing at least anodizing treatment and silicate treatment on an aluminum plate (abstract). In the silicate treatment alkaline earth metal salts can be formulated in the aqueous solution of alkali metal silicate such as calcium nitrate,

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strontium nitrate and magnesium nitrate in an amount of 0.01 to 10 wt % (column 5, line 21- column 6, line 23) which meet the present limitations for the treatment with an aqueous solution containing one or more divalent or multivalent cations. In Examples 4 to 6, undercoating solution 1 comprising a high molecular compound containing a monomer with pendant acid groups and a monomer with pendant onium groups was coated on an surface treated aluminum support. Photosensitive layer coating solution 2 comprising a cyanine dye was coated on the undercoating layer and dried to form plates 6 to 10. After exposure, alkali developer B was used to develop plates 6 to 15 (column 30, lines 21-35).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. In US 6,808,864 B2, Sawada et al. teach a support for lithographic printing plate and presensitized plate.
  - b. In US 6,806,031 B2, Endo et al. teach a presensitized plate having an anodized layer provided on a support for a lithographic printing plate.
  - c. In US 6,800,417 B2, Kikuchi teach a lithographic printing plate precursor.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Barbara L. Gilliam*

Barbara L. Gilliam  
Primary Examiner  
Art Unit 1752

bg  
February 17, 2005